

REMARKS

In this Response, Applicants amend claims 1, 55, and 68. No new matter has been added. Support for the claim amendments can be found at least at Applicants' Figure 3 and related text.

Claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, 39-43, 55, 56, 59, 60, 68, and 69 are currently pending, of which claims 1, 55, and 68 are independent. Applicants respectfully submit that all of the pending claims are in condition for allowance.

I. Telephone Interview with the Examiner

Applicants thank the Examiner for the telephone interview conducted on June 14, 2010. During the interview, Applicants described the non-liquid jet tissue-excision component recited in Applicants' claims, and argued that a combination of U.S. Patent No. 5,496,267 to Drasler et al. (hereafter "Drasler") and U.S. Patent No. 5,318,518 to Plechinger et al. (hereafter "Plechinger") does not disclose, teach or suggest a sharpened edge that extends circumferentially about the non-liquid jet tissue-excision component. The Examiner indicated that a claim amendment clarifying this feature of the sharpened edge is likely to overcome the cited references. The Examiner also indicated that she would need to conduct a further prior art search in considering the claim amendment.

II. Claim Amendments

In view of the Examiner interview, Applicants amend independent claims 1, 55, and 68 to expedite prosecution. The claim amendments should not be construed as acquiescence to the grounds for the Examiner's rejections set forth in the Office Action.

Applicants amend independent claims 1 and 68 to recite that the sharpened edge extends circumferentially about the non-liquid jet tissue-excision component. Similarly, Applicants amend independent claim 55 to recite that the sharpened peripheral rim extends circumferentially about the non-liquid jet tissue-excision component. No new matter has been added.

III. Claim Objections

Withdrawn claims 44-52 are objected to because the claim headings recite that the claims are “previously presented.” Applicants amend the claim headings to indicate that claims 44-52 are withdrawn. No new matter has been added. Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to claims 44-52.

IV. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, 39-43, 55, 56, 59, 60, 68, and 69 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drasler in view of Plechinger. Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, 39-43, 55, 56, 59, 60, 68, and 69 as set forth below.

A. Claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, and 39-43

Applicants respectfully submit that Drasler and Plechinger, alone or in any combination, fail to disclose, teach or suggest at least the following feature of amended independent claim 1: “a non-liquid jet tissue-excision component constructed and positioned at the distal end of the instrument to excise tissue during the surgical procedure, the non-liquid jet tissue-excision component located substantially opposite the jet-receiving opening and extending radially outward from a location defined by an axial center of the nozzle to a radial periphery having ***a sharpened edge extending circumferentially about the non-liquid jet tissue-excision component*** and in a direction substantially perpendicular to the axial center of the nozzle.”

In the Office Action, the Examiner acknowledges that Drasler does not disclose, teach or suggest the “non-liquid jet tissue-excision component” recited in claim 1 (Office Action, page 3). However, the Examiner cites the cutting edge 50 illustrated in Figure 7 of Plechinger as disclosing, teaching or suggesting this feature of claim 1 (Office Action, page 3). With reference to Figure 7 of Plechinger and Figure 3A of Drasler, the Examiner asserts that “when Drasler is modified in view of Plechinger, it is obvious the cutting edge would be placed in an analogous position and thus would extend from the nozzle (122) to the outer edge of the instrument in a direction perpendicular to the axial center of the nozzle (122), which is in line with the direction of the liquid jet” (Office Action, pages 5 and 6).

Applicants respectfully disagree with the Examiner's assertions and submit that at least in view of the current amendments, the combination of Drasler and Plechinger fails to establish a *prima facie* case of obviousness.

Applicants respectfully submit that the structure, function and operation of the devices of Plechinger and Drasler are directed exclusively to insertions into tubular tissues such as veins, fallopian tubes and urethras. As noted in Applicants' claim 1, the non-liquid jet tissue-excision component of the claimed invention is perpendicular to the axial center of the nozzle and therefore perpendicular to the direction of insertion. The claimed component is therefore exposed and any communication of the device into a vein, fallopian tube or urethra would pose an unacceptable risk of unintended lacerations. Accordingly, the orientation of the non-liquid jet tissue-excision component of the claimed invention would not be suitable for such use. One of ordinary skill in the art would not dispose the claimed non-liquid jet tissue-excision component in the Drasler device as depicted on page 5 of the Office Action, because the sharpened edge would be unsuitable for insertion in the types of vessels that the Drasler device is configured for insertion.

In addition, Figure 3A of Drasler shows a balloon 113 which holds the catheter against the deposit on the opposite wall for ablation and removal. The Examiner identifies areas 122, 124 in the Drasler device as being the location of sharpened edge in the modified version of the Drasler device. Over-inflation of the balloon 113 would push the areas 122, 124 of the catheter firmly against the vessel wall near the areas 122, 124. Were the sharpened edge disposed at the areas 122, 124, over-inflation of the balloon 113 would certainly create a significant risk of the sharpened edge puncturing the vessel wall. As discussed above, the non-liquid jet tissue-excision component of the claimed invention is perpendicular to the direction of insertion. One of ordinary skill in the art would not dispose the claimed non-liquid jet tissue-excision component in the Drasler device as suggested in the Office Action, because over-inflation of the balloon 113 would certainly create a significant risk of the sharpened edge puncturing the vessel wall.

Furthermore, Applicants respectfully submit that a combination of Drasler and Plechinger does not disclose, teach or suggest "*a sharpened edge extending circumferentially*

about the non-liquid jet tissue-excision component and in a direction substantially perpendicular to the axial center of the nozzle,” as recited in claim 1.

Drasler contains no disclosure, teaching or suggestion of a non-liquid jet tissue-excision component.

Plechinger does not cure the deficiency of Drasler. The cutting edge 50 of Plechinger does not have a sharpened edge extending circumferentially about a non-liquid jet tissue-excision component, as required by claim 1. As illustrated in Figure 7 of Plechinger, the non-liquid jet tissue-excision component of Plechinger is formed at the distal end of the irrigating catheter 2. The component includes a cutting edge 50 provided at the distal end of the catheter 2 for cutting material in an organ. The cutting edge 50 extends from the distal end of the catheter 2, but does not extend circumferentially about the distal end of the catheter 2. There is no disclose, teaching or suggestion in Plechinger of a cutting edge 50 that extends circumferentially about a non-liquid jet tissue-excision component. Plechinger contains no motivation for providing a cutting edge 50 that extends circumferentially about a non-liquid jet tissue-excision component. As such, Plechinger does not disclose, teach or suggest “*a sharpened edge extending circumferentially about the non-liquid jet tissue-excision component* and in a direction substantially perpendicular to the axial center of the nozzle,” as recited in claim 1.

As such, a combination of Drasler and Plechinger fails to disclose, teach or suggest each and every feature of claim 1.

Claims 2, 3, 6, 8, 11-17, 20-22, 24-26, 31, and 39-43 depend from claim 1 and, as such, include all of the features of claim 1. As such, a combination of Drasler and Plechinger also fails to disclose, teach or suggest each and every feature of claims 2, 3, 6, 8, 11-17, 20-22, 24-26, 31, and 39-43.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, and 39-43.

B. Claims 55, 56, 59, and 60

Applicants respectfully submit that Drasler and Plechinger, alone or in any combination, fail to disclose, teach or suggest at least the following feature of amended independent claim 55:

“a non-liquid jet tissue-excision component constructed and positioned to excise tissue during a surgical procedure, wherein the non-liquid jet tissue-excision component comprises a cup-shaped tissue receptacle having a sharpened peripheral rim located at the distal end of the instrument, *the sharpened peripheral rim extending circumferentially about the non-liquid jet tissue-excision component.*”

A combination of Drasler and Plechinger fails to disclose, teach or suggest a sharpened peripheral rim extending circumferentially about a non-liquid jet tissue-excision component, as required by claim 55. More specifically, the cutting edge 50 of Plechinger does not have a sharpened peripheral rim that extends circumferentially about a non-liquid jet tissue-excision component.

In addition, for at least the reasons discussed in connection with claim 1, Applicants respectfully submit that one of ordinary skill in the art would not dispose the claimed non-liquid jet tissue-excision component in the Drasler device as depicted on page 5 of the Office Action. This is because the sharpened rim would be unsuitable for insertion in the types of vessels that the Drasler device is configured for insertion, and over-inflation of the balloon 113 would certainly create a significant risk of the sharpened rim puncturing the vessel wall.

Claims 56, 59, and 60 depend from claim 55 and, as such, include all of the features of claim 55. As such, a combination of Drasler and Plechinger also fails to disclose, teach or suggest each and every feature of claims 56, 59, and 60.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claims 55, 56, 59, and 60.

C. Claims 68 and 69

Applicants respectfully submit that Drasler and Plechinger, alone or in any combination, fail to disclose, teach or suggest at least the following feature of amended independent claim 68: “a non-liquid jet tissue-excision component constructed and positioned at the distal end of the instrument to excise tissue during the surgical procedure, the non-liquid jet tissue-excision component located substantially opposite the jet-receiving opening and extending outward from a location defined by an axial center of the nozzle to a periphery having *a sharpened edge*

extending circumferentially about the non-liquid jet tissue-excision component and in a direction substantially perpendicular to the axial center of the nozzle.”

As discussed above in connection with claim 1, a combination of Drasler and Plechinger fails to disclose, teach or suggest a sharpened edge extending circumferentially about a non-liquid jet tissue-excision component, as required by claim 68.

In addition, for at least the reasons discussed in connection with claim 1, Applicants respectfully submit that one of ordinary skill in the art would not dispose the claimed non-liquid jet tissue-excision component in the Drasler device as depicted on page 5 of the Office Action. This is because the sharpened edge would be unsuitable for insertion in the types of vessels that the Drasler device is configured for insertion, and over-inflation of the balloon 113 would certainly create a significant risk of the sharpened edge puncturing the vessel wall.

Claim 69 depends from claim 68 and, as such, includes all of the features of claim 68. As such, a combination of Drasler and Plechinger also fails to disclose, teach or suggest each and every feature of claim 69.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claims 68 and 69.

CONCLUSION

In view of the above amendments and remarks, Applicants believe that all of the pending claims are in condition for allowance. Should the Examiner feel that a teleconference would expedite the prosecution of this application, the Examiner is urged to contact Applicants' attorney at (617) 449-6500.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-4876, under Order No. 118152-03801. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. § 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Dated: June 23, 2010

Respectfully submitted,

By: /David R. Burns/
David R. Burns
Registration No.: 46,590
McCARTER & ENGLISH, LLP
265 Franklin Street
Boston, Massachusetts 02110
(617) 449-6500
(617) 607-9200 (Fax)
Attorney/Agent For Applicant